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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/714,987	09/17/1996	HUGH SHARKEY	17616-705	4099

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 09/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/714,987

Applicant(s)

Shanbey

Examiner

J. Shanbey

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on June 27, 2003.
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 48, 50, 53-55, & 74-94 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 48, 50, 53-55, & 74-94 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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The rejections set forth in the previous office action are hereby repeated.

Claims 48, 50, 53, 74, 75, 77-83, and 85-88 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cosman et al (1984).

Wherein the interior of the electrode is the conductive material and the surface of the electrode is the surface material. Any interstitial fluid present will provide the composite temperature readings referred to. See Figure 2 and 3 and page 946, column 2 to page 948, column 2.

Claims 74, 76, 82, and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosman et al (1984) in combination with Cosman ('597). Cosman et al (1984) provide the teachings set forth above. Cosman ('597) teach forming electrodes of stainless steel. It would have been obvious to the artisan of ordinary skill to form the electrode of Cosman et al (1984) of stainless steel since this is a well known electrode material, and useful for forming thermocouple junctions, thus producing a device such as claimed.

Claims 54, 55, and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosman et al (1984) in combination with Makower et al. Cosman et al (1984) provide the teachings set forth above. Makower et al teach the equivalence of microwave, radio frequency, and resistive heating in energy delivery devices. It would have been obvious to the artisan of ordinary skill to employ a resistive or microwave tissue heater in the device of Cosman et al (1984), since these are well known equivalents in the art, as taught by Makower et al and provide no unexpected result, thus producing a device such as claimed.

Claims 89-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makower et al in combination with Cosman et al (1984). Makower et al teach a method such as claimed

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except for the specific recitation of moving and returning the applicator and the sensor completely enclosed by the thermally conductive material of the probe. Cosman et al (1984) teach a thermistor surrounded by conductive material. It would have been obvious to the artisan of ordinary skill to employ the energy applicator of Cosman et al (1984) in the method of Makower et al, since Makower et al teach no particular form for the high frequency applicator, and to re-insert the probe for subsequent treatment as taught by Makower et al page 20, thus sensing the combined temperature of the tissue and the fluids either exogenous or endogenous, therein, thus producing a method such as claimed.

Applicant appears to be arguing that Cosman et al (1984) does not read on the amended claims because there is no disclosure in Cosman et al (1984) to employ the device in an environment as discussed by applicant. This argument must fail for several reasons. Firstly, since the structure taught by Cosman et al (1984) reads on the claimed device, the device of Cosman et al (1984) would inherently behave as applicants claimed structure when put in the same environment. Secondly, the apparatus claims at bar do not recite the environment in which the device is to be used, and in fact cannot properly recite such environment, since this must include the patient's body structures (for example those tissues which would confine any irrigant in the operative space). And thirdly, the device of Cosman et al is intended to be used on the brain and spinal column, which are surrounded by cerebrospinal fluid, which would read on the fluid medium claimed.

Applicant's arguments filed June 27, 2003 have been fully considered but they are not persuasive. The arguments are not convincing for the reasons set forth above.

Applicant's arguments with respect to claims 89-94 have been considered but are moot in view of the new ground(s) of rejection.

This is a Request for Continued Examination of applicant's earlier Application No. 08/714,987. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.

Shay/DI

August 25, 2003



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330